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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,689	09/12/2003	James D.B. Smith	2003P12080US	7377

7590 12/03/2004

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

FULLER, ERIC B

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,689

Applicant(s)

SMITH ET AL.

Examiner

Eric B Fuller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 6,238,790) in view of Smith et al. (US 4,224,541).

Smith '790 teaches a patching resin for high voltage insulation comprising a resinous composition and metal intercalated AlSiO nano structures, where the patching resin is applied to the damaged area and cured (column 4, lines 11 and 29; column 9, line 55). Smith fails to explicitly teach the use of diluents in this composition. However, Smith '541 teaches that diluents reduce costs, decrease rigidity, and reduce viscosity for specific applications. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use diluents in the process taught by Smith '790. By doing so, one would reap the benefits of reduced costs and increased flexibility for use in low-viscosity applications. This combination reads on the applicant's claims, as shown in the previous Office Action.

Response to Arguments

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The declaration under 37 CFR 1.132, filed September 21, 2004, is insufficient to overcome the rejection of claims 1-21 based upon Smith et al. (US 6,238,790) in view of Smith et al. (US 4,224,541), as set forth in the last Office Action because it includes statements which amount to an affirmation that the affiant is of the opinion that the claimed subject matter is not obvious. Specifically, affiant alleges that diluents tend to have negative effects on resins with fillers, but provides no objective evidence thereof. See MPEP § 716.

Since the present invention contains filled resins and diluents, whereas one would expect the diluents to have a negative effect on the filled resins, the declaration implies that the claimed invention presents unexpected results. This is not convincing. The degree of the negative effect has not been alleged nor evidenced. Therefore, the affiant has not provided enough evidence in order to persuade the examiner that nonobviousness exists. For example, if the negative effects were small, i.e. only a small reduction in dielectric strength, yet the cost reduction was high, the benefits would exceed the negative effect and the combination would still be obvious. The affiant only merely alleges that there are negative effects and that one of ordinary skill in the art would not use diluents. No evidence has been given to support these allegations. See MPEP § 716.02. Furthermore, the claimed invention is open to both filled and unfilled resins.

Affiant further alleges that the '541 patent deals with resins that are unfilled and thus fails to make obvious adding diluents to a filled resin. This is not convincing. Column 10, lines 1-5, of the '541 patent explicitly states that the resins may be modified

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by adding diluents and fillers. Thus, it teaches a filled resin with diluents. Furthermore, the resins taught are the same. There is no factual basis in the allegation that the '541 patent only teaches unfilled resins.

It is also noted that the affiant alleges that it is against common practice to add diluents to filled resins since they tend to have an adverse effect on fillers. This is not found convincing. Ito et al. (US 2003/0074790 A1) explicitly teaches filled resins comprising reactive diluents. Thus, it is not against common practice.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (571) 272-1420. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck, can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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